

## REMARKS

The Office Action of November 21, 2005 was received and reviewed. The Examiner is thanked for reviewing this application and for withdrawing finality of the previous Office Action.

Claims 32-55 and 60-83 are pending for consideration, of which claims 32, 38, 44, 50, 60, 66, 72 and 78 are independent. Claims -14 and 31 have been withdrawn previously.

Referring now to the detailed Office Action, claims 32, 35, 36, 41, 42, 44, 47, 48, 50, 60, 66, 72 and 78 stand rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 15, 17, 18, 19, 27, 37, 46, 57, and 66 of U.S. Patent No. 6,274,887 to Yamazaki et al. (hereafter Yamazaki '887). This rejection is respectfully traversed at least for the reasons provided below.

Claims 32, 38, 44, and 50 of the present invention recite "an insulating film on the gate electrode and the pair of (conductive) side walls", and claim 72 recites that "a second insulating film on the first gate electrode and the pair of side walls". The protection film 108 is on the gate wiring 107 and the pair of side walls 109, as shown in Fig. 1 of the subject application. Applicants respectfully assert that the claims of the Yamazaki '877 patent do not recite the insulating film on the gate electrode and the pair of side walls.

Further, claims 60, 66 and 78 of the present invention recite "a second insulating film in contact with an upper surface and side surfaces of the (first) gate electrode". The protection film 1211 is in contact with an upper surface and side surfaces of the gate wiring 1006 as shown in Figs. 22A to 22E of the subject application. Applicants respectfully assert that the claims of the Yamazaki '877 patent also do not recite the insulating film in contact with an upper surface and side surfaces of the gate electrode.

Applicants note that claims 32-55 had been rejected over claims 1, 7, 8, 9, 15, 17, 19, 23, 25, 27, 37, 42, 44, 46, 57, 64 and 66 Yamazaki '877 in a double patenting rejection of obviousness-type in the Office Action mailed May 17, 2004, and that Applicants' response have already overcome the rejection because there was no rebuttal from the Examiner. Applicants note that subsequent rejections were based only on Kamiura but the rejections were also overcome.

As submitted in amendment filed October 18, 2004, Applicants respectfully assert again that the insulating film on the gate electrode and the pair of side walls of the presently

claimed invention is not equivalent to “wherein the first impurity region is in contact with the channel region and the insulating film” of Yamazaki ‘887.

As submitted previously, in the Yamazaki ‘877 patent, FIG. 1 shows the first impurity region 103 is in contact with the channel region 102 and the insulating film 106. On the other hand, in the subject application, FIG. 1 shows the insulating film 108 on the gate electrode 107 and the pair of sidewalls 109. Therefore, contrary to the Examiner’s assertion, the insulating film on the gate electrode and the pair of side walls is not equivalent to wherein the first impurity region is in contact with the channel region and the insulating film.

In the Office Action mailed November 21, 2005, the Examiner asserted that, although the conflicting claims are not identical, they are not patentably distinct from each other because it is obvious that a gate electrode will have more than one sidewall and it is well known to provide a pair of sidewalls on the gate electrode. In response, Applicants respectfully submit that the capability and knowledge of one of ordinary skill does not provide motivation or suggestion to modify the claims of the Yamazaki ‘877 patent. Therefore, it is respectfully asserted that the Office has not yet provided such suggestion or teaching. Moreover, Applicants respectfully direct the Examiner’s attention to MPEP 804 (page 800-22 Aug. 2001 Edition). It states the following:

*Any obviousness-type double patenting rejection should make clear:*

*(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and*

*(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.*


*When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.*

Accordingly, the burden is on the Office to establish why one of ordinary skill in the art would conclude that the invention recited in the instant claims 32, 35, 36, 38, 41, 42, 44, 47, 48, 50, 60, 66, 72 and 78 are an obvious variant of the invention recited in claims 1, 7, 8, 9, 15, 17, 19, 23, 25, 27, 37, 42, 44, 46, 57, 64 and 66 of the Yamazaki ‘877 patent. That is,

there must be a suggestion or teaching in the prior art that would motivate one of ordinary skill in the art to modify the invention recited in claims 1, 7, 8, 9, 15, 17, 19, 23, 25, 27, 37, 42, 44, 46, 57, 64 and 66 of the Yamazaki '877 reference, in spite of the differences noted by Applicants' above, to reach the invention recited in the instant claims 32, 35, 36, 38, 41, 42, 44, 47, 48, 50, 60, 66, 72 and 78. Applicants respectfully submit that the Examiner has a burden to make clear points (A) and (B) as stated in the MPEP and not merely making a conclusive statement that it is obvious for a gate electrode to have more than one sidewall and that it is well known to provide a pair of sidewalls on the gate electrode.

In view of the arguments set forth above, Applicants respectfully request reconsideration and withdrawal of the double patenting rejection, and that the application be passed to issue. If a conference would expedite prosecution of the instant application, the Examiner is hereby invited to telephone the undersigned to arrange such a conference.

Respectfully submitted,

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